

REMARKS

In the final Office Action dated November 14, 1994, the Examiner rejected claims 1-2 4-5, 9-10 and 16 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,779,725 to Gerber in view of U.S. Patent No. 3,061,057 to Miller. Furthermore, the Examiner rejected claims 3, 6-8 and 11 under §103 in view of other cited references. In response to this Office Action and in accordance with 37 C.F.R. § 1.116, Applicant has slightly amended independent claims 1, 7 and 16 to place in condition for allowance by including a limitation demonstrated in **Figures 2-4** that the inner surface of the removable single-walled panel member is "substantially contiguous" with the first longitudinal side of the golf bag, contrary to both Gerber and Miller. Such amendment was discussed with the Examiner in a telephone conference with the undersigned attorney on February 13, 1995.

As previously stated in a prior response by Applicants, Gerber discloses a golf bag having a removable dual-walled compartment including a front member (first wall) and a rear member (second wall) joined together by side panels and a zipper (See Col. 5, lines 20-22). The zipper extends about the side panels of the pocket allowing the pocket to be opened in notebook fashion but not removed (See Col. 5, lines 22-25). Rather, a number of fasteners, appearing to be flat-head screws which are inserted through the rear member of the pocket into a front side of the body portion of the golf bag, must be extracted before the pocket can be removed (See Col. 5, lines 29-38).

Moreover, Miller teaches a "side unit" including one side wall, two end walls, a bottom wall and a top wall and a zipper around the peripheral open edges formed by the top, bottom and end walls (See Col. 2, lines 20-25 and **Figure**

2). This side unit is used to increase the storage space of a hand bag (Col. 1, lines 32-33).

Combining the teachings of a circumferential zipper by Miller with the compartment of Gerber would still produce a dual-walled compartment with its front member (allegedly representing a single-walled panel) being contiguous its rear member, not the golf bag itself. This compartment is vastly different in structure than the present invention and thus, would not be as conducive in overcoming indicia affixation problems as the present invention.

Furthermore, combining the general golf bag construction of Gerber with the side unit of Miller would produce a removable front panel and side panels in contrast to the single-walled panel member as claimed by Applicants. These two factors clearly show that the combination product resulting from Gerber and Miller would be structurally different from Applicants' claimed single-walled panel member. As a result, Applicant respectfully requests the Examiner to withdraw his §103 rejection and allow claims 1-11, 15 and 16.

Alternatively, Applicant contends that the hand bag disclosed by Miller constitutes "non-analogous" art according to a two-step test adopted by the Federal Circuit (See In re Clay, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992)). According to the Federal Circuit, a cited reference is deemed non-analogous if (i) it is outside Applicants' field of endeavor and (ii) it is not reasonably pertinent to solving the problems addressed by the subject invention.

In this case, a hand bag falls outside Applicants' field of endeavor because the invention relates specifically to golf bags as explicitly stated in the "Field of the Invention" section of the subject application and throughout the application. As inferred from the numerous issued patent listed by the Examiner on "Form



IO-892", this field is quite established. In addition, Applicants' have satisfied the second step in that Miller is not reasonably pertinent to solving problems in sewing and stitching of indicia (patches, initials, etc.) onto bulky, cumbersome golf bags. This problem is specific to golf bags and not hand bags since the later can be opened to allow a person to attach indicia to one side of the hand bag without too much difficulty.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance and such allowance at the Examiner's earliest convenience is respectfully solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on February 13, 1995:

Wendi L. Rostan

2/13/95
Date